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SEP 0 5 2006

**OFFICE OF PETITIONS** 

In re Application of Miyazono et al. Application No. 09/903,068 Patent No: 6,982,319 Filed: July 11, 2001 Attorney Docket No. LUD5298.4 div

DECISION GRANTING PETITION AND NOTICE OF INTENT TO ISSUE CERTIFICATE OF CORRECTION

This decision is in response to Patentees' "REQUEST FOR PATENT TERM ADJUSTMENT (37 CFR 1.702 ET SEQ. 1.705(D), 35 U.S.C. 154)" filed on January 9, 2006 requesting that the Office adjust the Patent Term Adjustment determined at the time of the issuance of the patent from a determination of zero (0) days to a determination of 753 (days).

Patentees' request is **GRANTED-in-Part.** The correct amount of PTA at the time of the issuance of the patent is 533 days. The Office will also adjust the PTA calculation to reflect this decision.

The Office will *sua sponte* issue a certificate of correction reflecting this decision. Patentee is given **ONE MONTH OR (30) DAYS** WHICHEVER IS LONGER to respond to this decision if patentee believe this decision is in error. No extensions of time under 37 CFR 1.136 will be granted.

Patentees submitted a request asserting that they were entitled to a determination of 753 days of PTA based upon USPTO failing to issue the application within three years of the filing date pursuant to 37 CFR 1.702(b), a 533-day delay and USPTO failing to issue the application within four months of the payment of the issue fee under 37 CFR 1.704(2), a 220 day delay. Patentees assert that the 432-day reduction against PTA is in error. Patentees do not mention the 120-day reduction but believe that applicant is contesting that as well since the applicant did not assert that any patentee delay occurred during the pendency of the application. Nor did applicant mention the additional 8 days under 37 CFR 1.702(a)(1).

Patentees arguments are persuasive to the extent herein indicated. The Office missed the requirements of 37 CFR 1.702(a)(1) by a period of 8- days as determined by the USPTO. The Office missed the requirements of 37 CFR 1.702(b) by a period of 533 days as asserted by applicant and determined by the USPTO. As for the requirement of 37 CFR 1.702(a)(4), the Office asserts that the applicants responded to the April 21, 2004 notice of allowance on April 29, 2004 mailing an PTOL-85(B) equivalent back to the USPTO in which the patentee advised

the Office that the issue fee had been previously paid.<sup>1</sup> Accordingly, the Office's four month requirement under the patent term provisions of 35 U.S.C. § 154(b)(1)(A)(iv) and 37 CFR 1.702(a)(4) began on April 29, 2004.<sup>2</sup> The Office needed to issue the patent on/before August 29, 2004 to avoid USPTO delay. Accordingly, the amount of time delay in issuing the patent amount to 472 days.

Patentees are reminded that if an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See also Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule, 69 Fed. Reg. 21704 (April 22, 2004). Accordingly, the correct amount of administrative delay is 533 (533) days not 1013 (533 + 8 +472) days.

As for patentees, the patentees did not fail to engage in any reasonable efforts to conclude prosecution of the application. The 432- day reduction is in error because applicant replied to the 4/21/2004 notice of allowance on April 29, 2004. The Office entry of issue fee payment on September 26, 2005 is in error. In addition, the 120-day reduction for the 4/29/2004 miscellaneous incoming letter is also in error. The submission of the PTOL-85B equivalent on April 29, 2004 is not considered a failure to engage in reasonable efforts to conclude prosecution of the application under 37 CFR 1.704(c)(10). Accordingly, the proper amount of PTA at the time of the issuance of the patent is 553 days.

After the mailing of this decision, the Office will forward this patented file to the certificate of correction branch for an issuance of a certificate of correction. The certificate of correction branch will await the thirty day or one month period and then issue this certification of correction.

The Office has assessed the \$200.00 fee to deposit account 50-0624. No additional fees are required in determining this request for reconsideration of PTA.

Any questions concerning this decision should be directed to Kery Fries, Senior Legal Advisor, Office of Patent Legal Administration, Office of Deputy Commissioner for Patent Examination Policy at 571-272-7757.

Kery Fries

Senior Legal Advisor

<sup>&</sup>lt;sup>1</sup>Although applicant did not expressly state that they wanted the previously paid issue fee to be reapplied, the Office is construing the letter of April 29, 2004 as requesting reapplication of the previously paid issue fee.

<sup>&</sup>lt;sup>2</sup>It is unclear to the USPTO how patentees determined the issue fee payment date to be February 25, 2004.

Application No. 09/903,068

Office of Deputy Commissioner for Patent Examination Policy

cc: Draft certificate of correction Adjusted PAIR calculation



## PALM INTRANET

Day: Saturday Date: 9/2/2006 Time: 11:39:21

PTA Calculations for Application: <u>09/903068</u>					
Application Filing Date: 07/11/2001	PTO Delay (PTO):	541			
Issue Date of Patent: 01/03/2006	Three Years:	0			
Pre-Issue Petitions: 0	Applicant Delay (APPL):	552			
Post-Issue Petitions: 0	Total PTA (days):	533			
PTO Delay Adjustment: 544					

9/02/2006 2/14/2005 1/03/2006 1/28/2005	Contents Description  ADJUSTMENT OF PTA CALCULATION BY PTO  ADJUSTMENT OF PTA CALCULATION BY PTO  PTA 36 MONTHS  PATENT ISSUE DATE USED IN PTA  CALCULATION	552 533	8 	START
9/02/2006 2/14/2005 1/03/2006 1/28/2005	ADJUSTMENT OF PTA CALCULATION BY PTO PTA 36 MONTHS PATENT ISSUE DATE USED IN PTA	-	8	
2/14/2005 1/03/2006 1/28/2005	PTA 36 MONTHS PATENT ISSUE DATE USED IN PTA	-		
1/03/2006 1/28/2005	PATENT ISSUE DATE USED IN PTA	533		
1/03/2006				
		JL		
	RECEIPT INTO PUBS			
	DISPATCH TO FDC			
1/28/2005	APPLICATION IS CONSIDERED READY FOR ISSUE			
1/28/2005	WORKFLOW - SIGNATORY REVIEW - FINISH			
9/26/2005	ISSUE FEE PAYMENT VERIFIED			
1/21/2005	RECEIPT INTO PUBS			
9/26/2005	ISSUE FEE PAYMENT VERIFIED		432	49
1/07/70050	WITHDRAW PUBLICATION/PRE-EXAM ABANDON			
1/02/2005	PETITION TO REVIVE APPLICATION - GRANTED			
9/26/2005	PETITION ENTERED			
0/10/2/MASH				
9/19/70050	ABANDONMENT FOR FAILURE TO PAY ISSUE FEE			
9/15/2005	RECEIPT INTO PUBS			
4/29/2004	MISCELLANEOUS INCOMING LETTER		120	55
8/22/2005	RECEIPT INTO PUBS			
7/01/2005	WORKFLOW - QUERY REQUEST - FINISH			
	CRF IS GOOD TECHNICALLY / ENTERED INTO DATABASE			
1. 9 1. 9 1. 9 1. 9 1. 9 1. 9 1. 9 1. 9	/28/2005 /26/2005 /21/2005 //26/2005 //02/2005 //02/2005 //19/2005 //19/2005 //15/2005 //29/2004 //22/2005 //01/2005	ABANDON  PETITION TO REVIVE APPLICATION - GRANTED  ABANDON  ABANDON FETITION ENTERED  ABANDONMENT FOR FAILURE TO PAY ISSUE FEE  ABANDON FAILURE TO PAY ISSUE FEE  ABANDON FEE  ABANDON FEE  ABANDON FEE  ABANDON FEE  ABANDON FAILURE TO PAY ISSUE FEE  ABANDON FEE  ABANDON FEE  ABANDON FEE  ABANDON FEE  ABANDON FEE  ABANDON FAILURE TO PAY ISSUE FEE  ABANDON FEE	/28/2005 WORKFLOW - SIGNATORY REVIEW - FINISH /26/2005 ISSUE FEE PAYMENT VERIFIED /21/2005 RECEIPT INTO PUBS /26/2005 ISSUE FEE PAYMENT VERIFIED /02/2005 WITHDRAW PUBLICATION/PRE-EXAM ABANDON /02/2005 PETITION TO REVIVE APPLICATION - GRANTED /19/2005 PETITION ENTERED /19/2005 MAIL ABANDONMENT FOR FAILURE TO PAY ISSUE FEE /19/2005 RECEIPT INTO PUBS /29/2004 MISCELLANEOUS INCOMING LETTER /22/2005 RECEIPT INTO PUBS /01/2005 WORKFLOW - QUERY REQUEST - FINISH /22/2005 CRF IS GOOD TECHNICALLY / ENTERED INTO	1850E

55		MAIL MISCELLANEOUS COMMUNICATION TO APPLICANT		
54	03/02/2005	MISCELLANEOUS COMMUNICATION TO APPLICANT - NO ACTION COUNT		
53	10/18/2004	RECEIPT INTO PUBS		
52	06/08/2004	SEQUENCE FORWARDED TO PUBS ON TAPE		
51	06/17/2004	WORKFLOW - QUERY REQUEST - BEGIN		
50	05/11/2004	WORKFLOW - FILE SENT TO CONTRACTOR		
49	04/21/2004	MAIL NOTICE OF ALLOWANCE		
48	04/21/2004	MAIL FORMAL DRAWINGS REQUIRED		
47	04/21/2004	ISSUE REVISION COMPLETED		
46	04/21/2004	FORMAL DRAWINGS REQUIRED		
45	04/21/2004	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED		
44	04/21/2004	CASE DOCKETED TO EXAMINER IN GAU		
43	04/21/2004	NOTICE OF ALLOWABILITY		
42	04/20/2004	DATE FORWARDED TO EXAMINER		
41		SUPPLEMENTAL RESPONSE		
40	04/16/2004	CRF IS FLAWED TECHNICALLY / NOT ENTERED INTO DATABASE		
39	04/06/2004	WORKFLOW INCOMING AMENDMENT IFW		
38	03/11/2004	IFW AMENDED CASE PROCESSING COMPLETE		
37	02/25/2004	NEW OR ADDITIONAL DRAWING FILED		
36	03/11/2004	DATE FORWARDED TO EXAMINER		
35	02/25/2004	RESPONSE AFTER EX PARTE QUAYLE ACTION		
34	03/05/2004	ERROR(S) IN CRF CORRECTED BY STIC		
33	02/04/2004	MAIL EX PARTE QUAYLE ACTION (PTOL - 326)		
32	02/03/2004	EX PARTE QUAYLE ACTION		
31	01/30/2004	DATE FORWARDED TO EXAMINER		
30	01/30/2004	WITHDRAWAL OF NOTICE OF ALLOWANCE		
29	07/30/2003	ISSUE FEE PAYMENT RECEIVED		
28	05/20/2003	WORKFLOW - SIGNATORY REVIEW - BEGIN		
27	05/16/2003	MAIL NOTICE OF ALLOWANCE		
26	05/16/2003	MAIL FORMAL DRAWINGS REQUIRED		
25	05/16/2003	MAIL EXAMINER'S AMENDMENT		
24	05/16/2003	FORMAL DRAWINGS REQUIRED		
23	05/16/2003	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED		
22	05/16/2003	EXAMINER'S AMENDMENT COMMUNICATION		

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		NOTICE OF ALLOWABILITY	<u> </u>		
20	03/19/2003	DATE FORWARDED TO EXAMINER			
19	02/14/2003	RESPONSE AFTER NON-FINAL ACTION	<u> </u>		
18	12/11/2002	MAIL NON-FINAL REJECTION			
17	12/11/2002	NON-FINAL REJECTION			
16	10/15/2002	DATE FORWARDED TO EXAMINER			
15	10/14/2002	RESPONSE TO ELECTION / RESTRICTION FILED			
14	09/19/2002	MAIL RESTRICTION REQUIREMENT	8		-1
13	09/19/2002	REQUIREMENT FOR RESTRICTION / ELECTION			·
12	09/09/2002	CASE DOCKETED TO EXAMINER IN GAU			
11	09/04/2002	CASE DOCKETED TO EXAMINER IN GAU			
10	03/19/2002	PRELIMINARY AMENDMENT			
9	07/11/2001	PRELIMINARY AMENDMENT			
8	01/30/2002	CASE DOCKETED TO EXAMINER IN GAU			
7	01/23/2002	APPLICATION DISPATCHED FROM OIPE			
6	01/22/2002	APPLICATION IS NOW COMPLETE			
4	01/17/2002	CRF IS GOOD TECHNICALLY / ENTERED INTO DATABASE			
3	H(Y / /   X / / H W Y   I	CRF DISK HAS BEEN RECEIVED BY PREEXAM / GROUP / PCT			
2	07/25/2001	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	07/11/2001	INITIAL EXAM TEAM NN			

Search Another: Application# Search

## **EXPLANATION OF PTA CALCULATION**

## **EXPLANATION OF PTE CALCULATION**

To go back use Back button on your browser toolbar.

Back to PALM | ASSIGNMENT | OASIS | Home page

## UNITED STATES PATENT AND TRADEMARK OFFICE CERTIFICATE OF CORRECTION

PATENT

6,982,319 B2

DATED

Jan. 3, 2006

INVENTOR(S):

Miyazono et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[\*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by (0) days

Delete the phrase "by 0 days" and insert - by 533 days--